

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE:

APPLICATION OF

TITLE



David E. Patterson and Richard D. Cramer

A Further Method Of Creating And Rapidly
Searching A Virtual Library Of Potential
Molecules Using Validated Molecular Structural
Descriptors

FILING DATE : May 25, 2001

APPLICATION SERIAL NO. : 09/866,543

ART UNIT : 1631

EXAMINER : Marjorie A. Moran

ATTORNEY FILE NO. : 3017-56

TO: Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

RESPONSE TO RESTRICTION OR ELECTION REQUIREMENT

Dear Sir:

Applicants have filed herewith a Petition for Extension of Time along with the required fee. This response is being timely filed within the extended period. By Office Action dated December 17, 2003, the Examiner indicated that claims 1 - 9 in this application are subject to a requirement for restriction or election.

In order to comply with the Rules governing response to restriction requirements, Applicants hereby elect Group I, claim no. 1. Applicants respectfully present the following traverse with respect to Groups II and III.

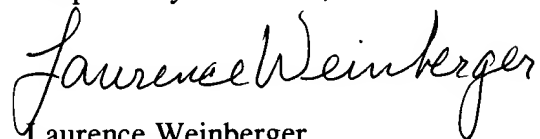
Applicants have exercised their right to claim their invention in as many different ways as is reasonable. There are not three different inventions claimed in claims 1-3, but rather one

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invention presented in claims having different breadth. For instance, claim 2 is a narrower version of claim 1 having an additional subsection (d) added to claim 1. Claim 3 is the broadest claim for which claims 1 and 2 are narrower versions. Perhaps it would have made more sense to present the claims in the order 3, 1, and then 2. The claims are essentially product by process claims. The method claims, which recite the process for each of the claims in the application, issued in U.S. Patent No. 6,240,374 on May 29, 2001. Claim 1 of the '374 patent parallels claim 3 of the application. Claim 7 of the '374 patent parallels claim 1 of the application. Claim 36 of the '374 patent parallels claim 3 of the application. Just as claims 1, 7, and 36 of the issued patent present claims of different scope directed to the same invention, so do claims 1-3 of the application. There should not be an undue burden placed on the Examiner by examining all three claims together, especially since they: 1) define the same invention; and 2) as noted by the Examiner, are all classified in the same class and subclass.

Accordingly, Applicants' respectfully request that the Examiner withdraw the restriction requirement to the claims of Group II and Group III.

Respectfully submitted,



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